

35 U.S.C. §103 Prima Facie Case of Obviousness Not Established

Claims 1-4 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Wang, United States Patent No. 6,039,453 in view of Wu, United States Patent No. 6,022,118. The courts have established the legal concept of *prima facie* obviousness and the initial burden of factually supporting any *prima facie* conclusion of obviousness rests on the Examiner. To properly establish a *prima facie* case of obviousness, three (3) basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. (See MPEP §2143.)

In this case the Examiner can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in the Wang or Wu references or in the knowledge generally available to one of ordinary skill in the art, at the time the claimed invention was made, which would lead that individual to modify Wang in view of Wu to do what the Applicant did in the claimed invention.

It is respectfully submitted that the Examiner has raised nothing but a bare assertion that it would have been obvious to modify Wang to create the Applicant's claimed globe. This does not meet the burden required of the Examiner. The ease or simplicity with which the Applicant's claimed invention can be obtained is not sufficient criteria for a rejection under 35 U.S.C. §103. The correct and only standard to be used is whether it would have been obvious to make the claimed invention. The mere apparent simplicity of reaching a claimed invention is in no way linked with the ease or simplicity in which the Examiner establishes a *prima facie* case of obviousness.

"The Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the matter claimed". In re Rouffet, 149 F3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998).

Specifically, claims 1-3 have been rejected because the Examiner asserts that Wang discloses all of the features in the claimed invention, "except for a rotated support and electric motor". (Office Action page 2.) The Examiner has asserted that the two items of the rotated support and the electric motor of Wu would have been obvious to combine with Wang and thereby yield the claimed invention. The Examiner has not identified any disclosure, teaching or suggestion in the references cited, or in the knowledge encompassed by one of ordinary skill in the art, to create the claimed invention. There simply is no motivation to make the modification to the reference as suggested by the Examiner.


Additionally, even if the references were properly combined and the rotated support and electric motor of Wu were combined with the globe of Wang for rotation of the outer globe, the resulting combination would not constitute Applicant's claimed invention. The proposed combination simply would not disclose, teach or suggest an "inner globe carrying an image on its surface" or "an electric light bulb inside the inner globe", or an image "projected onto the inner surface of the outer cover and is visible from outside the outer cover". Simply put, the prior art references of Wang and Wu, when combined, do not teach or suggest all of the claimed limitations, and as such do not support the Examiner's rejection.

With regard to rejection of Claim 4 on the basis that it would have been obvious to provide an image of a map of the world of Wu on the globe of Wang, neither Wang, nor Wu discloses, teaches or suggests an "inner globe carrying an image on its surface" or "an electric light bulb inside the inner globe", or an image "projected onto the inner surface of the outer cover and is visible from outside the outer cover". Configuring the reference of Wang to project an image clearly not only has no support in the disclosure, teaching or suggestion of the references, but in fact such a proposed combination would not result in the claimed invention and would require a substantial reconstruction and redesign of the elements shown in Wang, as well as a change in the basic principle under which the Wang construction was designed to operate. This reconstruction and redesign has long been established not to be a basis for rejection under 35 U.S.C 103. In re Ratti, 270 F2d 810, 123 USPQ 349 (CCPA 1959).

For the foregoing reasons, it is respectfully submitted that all claims in the application are in condition for allowance. Accordingly, reconsideration and a prompt favorable action thereon are earnestly solicited.

Respectfully submitted,

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